

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Timothy R. SPOONER et al. **GROUP:** 2826

SERIAL NO: 10/006,964 **EXAMINER:** T. Dickey

FILED: December 5, 2001

**FOR: METHOD AND DEVICE FOR PROTECTING MICRO
ELECTROMECHANICAL SYSTEMS STRUCTURES DURING
DICING OF A WAFER**

**Assistant Commissioner of Patents
Washington, D.C. 20231**

Sir:

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RESPONSE UNDER 37 C.F.R. 1.111

OFFICE OF PETITIONS

In response to the Office Action mailed May 1, 2003, the following remarks are respectfully submitted under 37 C.F.R. 1.111 in connection with the above-identified application.

REMARKS

Claims 1-145 are pending in the present application.

The Examiner has alleged that the presently pending claims are directed to three (3) Groups of distinct inventions. More specifically, the Examiner alleges that the presently pending claims are directed to the patentably distinct Group I (claims 25-30, 44-49, 63-68, 70-72, 74-76, 78-80, and 137-139), Group II (claims 81-121, 131-136, and 140-145), and Group III (claims 1-24, 31-43, 50-62, 73, 77, and 122-130). These assertions by the Examiner and follow-on restriction requirement are respectfully traversed for the following reasons.

Initially, in discussing the relationship between the inventions of Groups III and I, the Examiner asserts that the invention of Group III is **NOT** distinct from the invention of Group I and thus the Examiner would examine the inventions of Groups I and III together, if the Applicants so elect. Moreover, in discussing the relationship between the inventions of Groups

II and III, the Examiner asserts that the invention of Group III is **NOT** distinct from the invention of Group II and thus the Examiner would examine the inventions of Groups II and III together, if the Applicants so elect.

It is clear by the Examiner's own admissions, as summarized above, that there is no grounds for asserting a restriction requirement.

More specifically, the Examiner asserts that the inventions of Groups I and III are not distinct, and thus, according to the Examiner's assertions, the invention defined by the claims of Group I is same as the invention defined by the claims of Group III. The Examiner also asserts that the inventions of Groups II and III are not distinct, and thus, according to the Examiner's assertions, the invention defined by the claims of Group II is same as the invention defined by the claims of Group III. If the claims of Group I define the same invention as defined by the claims of Group III, and the claims of Group II define the same invention as defined by the claims of Group III, it must follow that the claims of Group I define the same invention as defined by the claims of Group II. In other words, if **A** (the invention as defined by the claims of Group I) equals **B** (the invention as defined by the claims of Group III) and **B** (the invention as defined by the claims of Group III) equals **C** (the invention as defined by the claims of Group II), **A** (the invention as defined by the claims of Group I) must equal **C** (the invention as defined by the claims of Group II).

Therefore, since, by the Examiner's own admission, there are no grounds for a restriction requirement, the Applicants respectfully request the Examiner to withdraw the present restriction requirement.

The Examiner further asserts that the claims of Group II are related to the claims of Group I as the process of making and product made. To support this conclusion, the Examiner asserts that the product claims 81, 96, and 109 of Group II can be made from a process that is materially different than the process defined by the claims 25-27, 44-46, and/or 63-65 of Group I. More specifically, the Examiner alleges that the product claims 81, 96, and 109 of Group II can be made wherein the flexible film and tape are cut or punched before being combined, and

that this exemplary process proffered by the Examiner is a materially different from the process defined by the claims of Group I. This is respectfully traversed.

Claims 28, 29, 47, 48, 66, and/or 67 of Group I define a process wherein the flexible film and tape are cut or punched before being combined. Therefore, since the exemplary process proffered by the Examiner (“the flexible film and tape are cut or punched before being combined”) is covered by claims (claims 28, 29, 47, 48, 66, and/or 67) within Group I, the exemplary process proffered by the Examiner (“the flexible film and tape are cut or punched before being combined”) **CANNOT** be a process that is materially different from the process defined by the claims of Group I, namely claims 28, 29, 47, 48, 66, and 67 of Group I.

The Examiner further alleges that the product claims 81, 96, and 109 of Group II can be made wherein the flexible film and tape are cut or punched after being combined, and that this second exemplary process proffered by the Examiner (“the flexible film and tape are cut or punched after being combined”) is a materially different from the process defined by the claims of Group I. This is respectfully traversed.

Claims 25-27, 44-46, and/or 63-65 of Group I define a process wherein the flexible film and tape are cut or punched after being combined. Therefore, since the second exemplary process proffered by the Examiner (“the flexible film and tape are cut or punched after being combined”) is covered by claims (claims 25-27, 44-46, and/or 63-65) within Group I, the second exemplary process proffered by the Examiner (“the flexible film and tape are cut or punched after being combined”) **CANNOT** be a process that is materially different from the process defined by the claims of Group I, namely claims 25-27, 44-46, and 63-65 of Group I.

In conclusion, the Examiner, by the Examiner’s own admission, has failed to demonstrate proper grounds for asserting a restriction requirement between the claims of Group I and the claims of Group II. Therefore, since the Examiner has failed to provide proper grounds for a restriction requirement between the claims of Group I and the claims of Group II, the Applicants respectfully request the Examiner to withdraw the present restriction requirement between the claims of Group I and the claims of Group II.

Lastly, the Examiner, notwithstanding the various admissions by the Examiner to the contrary, asserts that the inventions of Groups I, II, and III are distinct and thus are subject to a restriction requirement. For all the reasons set forth above, this final assertion by the Examiner is respectfully traversed.

Accordingly, in view of all the reasons set forth above, the Examiner is respectfully requested to reconsider and withdraw all the various restriction requirements.

However, to expedite the prosecution of the present application, the Applicants elect, **with traverse**, claims 1-24, 31-43, 50-62, 69, 73, 77, and 122-130 as being drawn to Group III. Moreover, the Applicants elect, **with traverse**, claims 25-30, 44-49, 63-68, 70-72, 74-76, 78-80, and 137-139 as being drawn to Group I because the Examiner indicated in the Office Action that, if the Applicants so elect, the claims of Group I and III would be examined together. Lastly, the Applicants elect, **with traverse**, claims 81-121, 131-136, and 140-145 as being drawn to Group II because the Examiner indicated in the Office Action that, if the Applicants so elect, the claims of Group II and III would be examined together. Also, an early indication of allowability is earnestly solicited.

Respectfully submitted,



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